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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,543	07/07/2000	Makoto Funabashi	1982-0153P	9387
7590 08/17/2007 Birch Stewart Kolasch & Birch LLP P O Box 747 Falls Church, VA 22040-0747			EXAMINER LIN, JAMES	
			ART UNIT 1762	PAPER NUMBER
			MAIL DATE 08/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/612,543	Applicant(s) FUNABASHI, MAKOTO	
	Examiner Jimmy Lin	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 06 August 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 14-19.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,4,9-12,20,24 and 25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

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Box 7:

The amendment of “mixed in a ratio by weight of 1:8 to 1:40” to claim 25 overcomes the 35 U.S.C. 112, 2nd paragraph rejection. Jamil teaches such a weight ratio of 1:8.5 (col. 13, lines 14-24).

Box 11:

The Applicant argues on pg. 8 that MEK is included in a number of usable solvents mentioned in Jamil but the Examiner is not accounting for the fact that the inventive method has advantages which would not be expected based on the teachings of Jamil. The Applicant further argues that the Declarations filed on 6/25/04 and 4/12/05 provides evidence of the advantageous effects achieved by the use of MEK as the dispersing solvent for the first slurry. However, the Declaration filed on 6/25/04 merely shows the effects of physical force applied to a stimuable phosphor, and the Declaration filed 4/12/05 merely compares the effect of the order of steps when performing wet-classification and addition of binder in addition to a comparison of stirring versus ball milling. Neither the Declarations nor the specification show a comparison of using MEK versus a different solvent. Therefore, there is no evidence on the record showing that the use of MEK as a solvent has unexpected results.

The Applicant argues on pg. 8 that even if the solvent for the second slurry can be selected from those listed as the dispersing solvent for the first slurry, this does not mean that the dispersing solvent for the first slurry can be selected from those listed as the solvent for the second slurry. The Office takes the position that Jamil teaches that MEK can be the particular solvent for the first slurry (col. 11, lines 21-26). The solvent for the second slurry can also be MEK because Jamil teaches that the second solvent can be the same as the first solvent (col. 12, lines 29-32) and because Jamil explicitly exemplifies MEK as the particular second solvent (col. 12, lines 35-38).

The Applicant argues on pg. 8 that Jamil differentiates the dispersing slurry for the first slurry from the solvent for the second slurry and teaches that the solvent for the second slurry needs to additionally have compatibility. The Applicant further argues that “compatibility” is considered to mean the ability to dissolve the binder from the context. However, Jamil makes no indication that “compatibility” has such a meaning and the Applicant does not further explain

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how the context would suggest such a meaning. Additionally, it is unreasonable to compare the first slurry and the second slurry in terms of dissolving a binder because only the second slurry contains the binder. The first slurry does not contain any binder, but that does not mean the binder would not have “compatibility” or be dissolved in the first slurry. Moreover, Jamil explicitly teaches that the second solvent can be chosen from the same list as those used for the first solvent, thereby suggesting that the first and second solvents would have similar functions in the slurries.

The Applicant argues on pg. 8-9 that it would be very difficult for a person skilled in the art to find that MEK is particularly preferred as the dispersing solvent for the first slurry because the skilled person would naturally understand that the compatibility is not an essential feature for the dispersing solvent for the first slurry. However, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Because Jamil explicitly teaches that MEK can be used as the solvent in the first slurry, one of ordinary skill would have been led to use MEK as the particular solvent in the first slurry.

The Applicant argues on pg. 9-10 that a person skilled in the art would not have found it obvious to omit the drying step no matter what kind of solvent was used because it is clear that the formation of phosphor powder is an essential step in the processes described in Jamil and because the Applicant has found that aggregation of particles occurs during the drying step for making powder. However, the Applicant’s arguments that Jamil makes the statement “a method of producing a phosphor powder” is not sufficient evidence to show that a drying step to form the powder is critical. In Examples I to III in Jamil, the phosphors are dried only to determine the particle size distribution. Thus, the drying step does not actually seem to be an essential and necessary step. Additionally, the motivation for a *prima facie* case of obviousness does not have to be the same as that of the Applicant’s. Although the Applicant may have found that drying the powder may form aggregates and the omission of the drying step may prevent such a phenomenon, one of ordinary skill in the art would have omitted the drying step for different

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reasons, such as for the advantage of reducing the number of steps in a process, in view of the fact that the drying step has no criticality.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is 571-272-8902. The examiner can normally be reached on Monday thru Friday 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER